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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,754

02/02/2007

Jalaj Arora

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2942

30678

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01/14/2011

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EXAMINER

COUGHLIN, MATTHEW P

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

01/14/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,754	Applicant(s) ARORA ET AL.	
	Examiner Matthew P. Coughlin	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,10-16,18,19,25-27 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) 33-38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 1,3,10-16,18,19,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1, 3, 10-16, 18-19, 25-27 and 33-38 are pending in the application. Claims 1, 3, 10-16, 18-19 and 25-26 are rejected. Claim 27 is allowed. Claims 33-38 are withdrawn from further consideration.

Response to Amendment / Argument

The examiner has withdrawn the finality of the action dated August 11th, 2010. Applicant's submission on January 10th, 2011 has been entered.

Objections and rejections made in the previous Office Action that do not appear below have been overcome by Applicant's amendments to the claims. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Objections

Applicant is advised that should claim 13 be found allowable, claim 19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 12 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the

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other as being a substantial duplicate of the allowed claim. See MPEP

§ 706.03(k).

Double Patenting

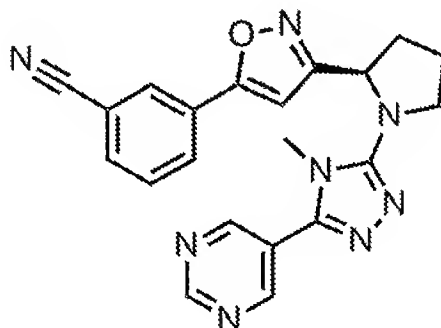
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 3, 10-16, 18-19 and 25-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 7,678,796. Although the conflicting claims are not identical, they are not patentably distinct from each other because the genus of the patent appears to be wholly encompassed by the instant claims such that every species falling within the genus of the patent anticipates the instant claims. Particular preference for compounds instantly claimed can be seen in the species of claim 18 of the patent where, for instance, the first compound (3-{3-[(R)-1-(4-Methyl-5-pyrimidin-5-yl-4H-[1,2,4]triazol-3-yl)-pyrrolidin-2-yl]-isoxazol-5-yl}-benzonitrile) has the following structure:

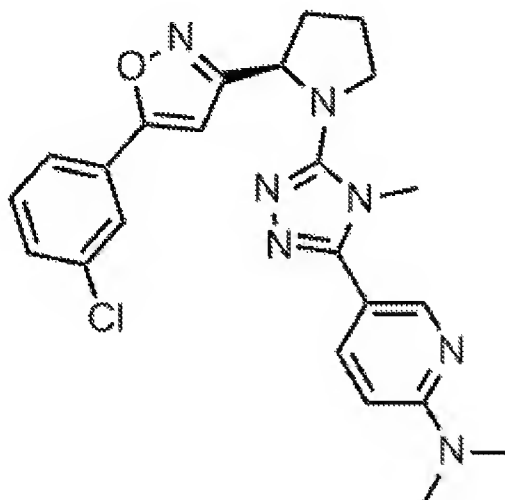


The species shown above is embraced by Applicant's variables in that m is 1, R1 is cyano, X1 is CR4 where R4 is hydrogen, X2 and X7 are C, X3 is O, X4 is N, X5 is a bond, p is 0, X6 is N, Q is triazolyl, n is 2 where one instance of R2 is alkyl and the other is a 6-membered ring containing C and N.

Claims 1, 3, 10-16, 18-19 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 and 26-27 of copending Application No.

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12/258165. Although the conflicting claims are not identical, they are not patentably distinct from each other because the genus of the co-pending application appears to be wholly encompassed by the instant claims such that every species falling within the genus of the co-pending application anticipates the instant claims. Particular preference for compounds instantly claimed can be seen in the species of claim 13 of the co-pending application where, for instance, the first compound (5-(5-((2R)-2-[5-(3-Chlorophenyl)isoxazol-3-yl]pyrrolidin-1-yl)-4-methyl-4H-1,2,4-triazol-3-yl)-N,N-dimethylpyridin-2-amine) has the following structure:

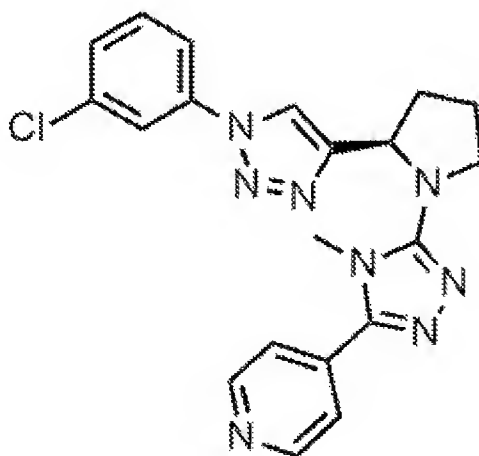


The species shown above is embraced by Applicant's variables in that m is 1, R1 is halogen, X1 is CR4 where R4 is hydrogen, X2 and X7 are C, X3 is O, X4 is N, X5 is a bond, p is 0, X6 is N, Q is triazolyl, n is 2 where one instance of R2 is alkyl and the other is a 6-membered ring containing C and N, which is further substituted by A where A is NR5R6 where R5 and R6 are each alkyl.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 1, 3, 10-12, 14-16, 18-19 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 27-28 of copending Application No. 12/258161. Although the conflicting claims are not identical, they are not patentably distinct from each other because the genus of the co-pending application appears to be wholly encompassed by the instant claims such that every species falling within the genus of the co-pending application anticipates the instant claims. Particular preference for compounds instantly claimed can be seen in the species of claim 14 of the co-pending application where, for instance, the first compound (4-(5-((2R)-2-[1-(3-Chlorophenyl)-1H-1,2,3-triazol-4-yl]pyrrolidin-1-yl)-4-methyl-4H-1,2,4-triazol-3-yl)pyridine) has the following structure:



The species shown above is embraced by Applicant's variables in that m is 1, R1 is halogen, X1 is CR4 where R4 is hydrogen, X2 is N, X7 is C, X3 is N, X4 is N, X5 is a bond, p is 0, X6 is N, Q is triazolyl, n is 2 where one instance of R2 is alkyl and the other is a 6-membered ring containing C and N.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claim 27 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew P. Coughlin whose telephone number is (571)270-1311. The examiner can normally be reached on Monday through Thursday from 12:00 pm - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew P. Coughlin/
Examiner, Art Unit 1626

/Joseph R Kosack/

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Primary Examiner, Art Unit 1626